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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re FMR Corp.

Serial No. 75/871,163

Timothy H. Hiebert of Samuels, Gauthier & Stevens for FMR Corp.

Monique C. Miller, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Simms, Walters and Chapman, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

FMR Corp. filed an application to register on the Principal Register the mark 401K.COM for, as amended, "providing financial information and information about investment account activity by means of a global computer information network; investment management services;

Serial No. 75/871,163

retirement fund investment services," in International Class 36.¹

The Trademark Examining Attorney initially refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's proposed mark is merely descriptive when used in connection with its services. Applicant responded, on June 7, 2000, by amending its application to seek registration on the Supplemental Register. The Examining Attorney accepted the amendment and issued a refusal to register, which was ultimately made final, under Section 23 of the Trademark Act, 15 U.S.C. 1091, on the ground that the proposed mark is generic in connection with the identified services.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

With respect to genericness, the Office has the burden of proving genericness by "clear evidence" thereof. *In re Merrill, Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). The critical issue in genericness cases is

¹ Serial No. 75/871,163, filed December 14, 1999, based on use of the mark in commerce, alleging first use and use in commerce as of August 1998.

whether members of the relevant public primarily use or understand the term sought to be registered to refer to the category or class of goods or services in question. *In re Women's Publishing Co. Inc.*, 23 USPQ2d 1876, 1877 (TTAB 1992). Our primary reviewing court has set forth a two-step inquiry to determine whether a mark is generic: First, what is the category or class of goods or services at issue? Second, is the term sought to be registered understood by the relevant public primarily to refer to that category or class of goods or services? *H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

Applicant and the Examining Attorney agree that the broader class of services involved herein is "financial and investment services," although we note that the application also specifically includes "retirement fund investment services," which is a class of services within the more general class of "financial and investment services." Regarding the relevant public's understanding of the term 401K.COM, the Examining Attorney submitted the following definitions:

.com -

(.COMmercial) A top-level Internet domain used mostly by businesses in the U.S. and Canada. However, there are .com Web sites in almost every country in the world as well as for individuals. Many believe the .com domain is the most desirable, because it was the first commercial domain name, and all the major companies in the world have .com Web sites. www.techweb.com/encyclopedia, *The Business Technology Network TechEncyclopedia*, October 9, 2001.

401(k) -

A tax-deferred defined contribution retirement plan offered by an employer. www.cnnfn.cnn.com, *Glossary of Business Terms*, December 6, 2000.

A retirement investment plan that allows an employee to put a percentage of earned wages into a tax-deferred investment account selected by the employer. *The American Heritage Dictionary of the English Language*, 3rd ed. 1996.

A retirement account to which employee and employer contribute, on which taxes are deferred until withdrawal, and for which the employee selects the types of investments. Etymology: from the section of the Internal Revenue Code that established it. *Merriam-Webster's Collegiate Dictionary*, 2000.

Additionally, the Examining Attorney submitted a substantial number of excerpts of articles retrieved from the LEXIS/NEXIS database reflecting numerous uses of the terms "401k" and "401k plan" to refer to the type of retirement investment account defined above; and numerous uses of 401K.COM as applicant's Internet web address in articles about applicant. She also submitted an excerpt,

dated May 9, 2000, from applicant's Internet web site located at www.401k.com, which includes on the top banner the slogan "we help you invest responsibly for retirement," and in the body of the page the following statements:

www.401k.com is Fidelity Investments' World Wide Web site designed to provide investment education, market analysis, tools, and resources especially for people investing for retirement through a company-sponsored 401(k) plan. Our goal is to provide education that helps people make informed decisions about their investments so they may retire comfortably.

In her brief, the Examining Attorney contends that this case is analogous to the recently-decided precedential Board decision in *In re Martin Container, Inc.*, Serial No. 75/553,426, 2002 TTAB LEXIS 360, June 11, 2002 [CONTAINER.COM held generic in connection with "buying, selling, and renting metal shipping containers"]. She presented the following arguments regarding the facts herein:

To the average customer seeking to obtain information about investing in a retirement account, "401K.COM" would immediately indicate a commercial web site on the Internet that provides information or services related to 401k accounts. There is no question that, by use of applicant's services, one may obtain information about tax-deferred defined contribution retirement plans offered by an employer pursuant to the section of the Internal Revenue Code "401(k)" establishing such plans, as evidenced by the "401K" component of the mark. The

element ".COM," the so-called top-level domain name, is merely the address element used to access online computer information and merely indicates that applicant is a commercial entity. Applicant's mark as a whole [immediately] tells users that they may access applicant's services via the Internet to obtain information about financial information and investment accounts ... or retirement accounts. ... There is no question but that a central feature of applicant's "financial information" services, "investment management services," and "retirement fund investment services" is that they pertain to 401(k) plans.

Applicant contends that, with respect to establishing the public understanding of the term, the Examining Attorney has dissected the mark and analyzed "401K" and ".COM," and has not shown that the combined term, "401K.COM," "is actually used by anyone as a genus name for financial and investment services." Applicant states that the Examining Attorney's approach resembles the approach taken by the Federal Circuit in *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) [compound term, SCREENWIPE, formed by the union of two generic terms is generic if the compound term has the same meaning common usage would ascribe to the individual words]; but that the *Gould* approach was limited by the Court in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999), [genericness determination must be based on the meaning as a whole of

the phrase SOCIETY FOR REPRODUCTIVE MEDICINE, not based only on definitions and generic uses of the constituent terms of the mark]; and that *In re Dial-A-Mattress Operating Corp.*, 24 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), presents an analogous situation to the case herein.

In *Dial-A-Mattress*, the Court concluded that the Board had erred in finding the term 1-888-M-A-T-R-E-S-S generic for telephone shop-at-home retail services in the field of mattresses; and the Court found that the term is merely descriptive in connection with the identified services and the evidence of applicant's prior registrations is sufficient to establish acquired distinctiveness.

The Court stated the following:

Here, there is no dispute that the genus is telephone shop-at-home services for retail mattresses. Nor does Dial-A-Mattress contest the following evidence and legal conclusions offered by the Director: (1) the area code designation (888) in the proposed mark by itself is devoid of source-indicating significance; (2) "matress" is the legal "equivalent" of the word "mattress"; and (3) the word "mattress" standing alone is generic for retail services in the field of mattresses.

However, the Court found that the Board erred by applying to this case the test established in *In re Gould Paper Corp.*, *supra*. The Court in *Dial-A-Mattress*

reasoned that the term 1-888-M-A-T-R-E-S-S is not like a compound word; rather it is analogous to the phrase involved in *In re American Fertility Society, supra*.

Thus, applying the test established in *American Fertility Society*, the Court concluded that "[t]he Director must produce evidence of the meaning the relevant purchasing public accords the proposed mnemonic mark 'as a whole.'"

In this regard, the Court stated the following:

Analyzing the "1-888-M-A-T-R-E-S-S," mark as a whole, substantial evidence does not support the conclusion that the mark is generic. There is no record evidence that the relevant public refers to the class of shop-at-home telephone mattress retailers as "1-888-M-A-T-R-E-S-S." "Telephone shop-at-home mattresses" or "mattresses by phone" would be more apt generic descriptions. Like the title "Fire Chief" for a magazine in the field of fire fighting, a phone number is not literally a genus or class name, but is at most descriptive of the class. Moreover, like the term "cash management account," "1-888-M-A-T-R-E-S-S" does not "immediately and unequivocally" describe the service at issue. (*Citations omitted*.)

Applicant draws the following analogy between this case and the *Dial-A-Mattress* case:

Like the "888" dialing prefix in Dial-A-Mattress, "401K" in "not a word." It is a combination of a number and a letter identifying an Internal Revenue Code section. Furthermore, the ".COM" domain name suffix is also not a word, and is not itself generic for financial and investment services.

Applicant's mark is typically pronounced as six separate word-like components, as "Four-O-One-K-

Dot-Com." Like the mark at issue in *Dial-A-Mattress*, 401K.COM thus "bears a closer conceptual resemblance to a phrase than a compound word." *Id.*

Furthermore, like a mnemonic telephone number (in which a word corresponds to numbers which might otherwise be difficult to recall), a domain name functions by allowing the user to type a unique and memorable name into a web browser, and thus avoid the need to remember the series of numbers on which the computer relies for routing purposes.

In the recent decision of *In re Martin Container, Inc.*, *supra*, cited by the Examining Attorney, the Board found the mark CONTAINER.COM to be generic in connection with retail sales and rental of containers. In that case, the Board stated the following:

In the case before us, contrary to *Dial-A-Mattress*, the mark cannot be characterized as a mnemonic phrase. It is instead a compound word, a generic term combined with the top level domain indicator, ".COM." In proving genericness, the Office may satisfy its burden by showing that these separate generic words have a meaning identical to the meaning common usage would ascribe to those words as a compound. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987). In a similar sense, neither the generic term nor the domain indicator has the capability of functioning as an indication of source, and combining the two does not result in a compound term that has somehow acquired this capability.

Applicant contends that .COM is not merely an entity designator because it is used by both businesses and individuals; that "its primary significance when combined

with numbers or other letters is to identify a means by which a customer may obtain information, interact with others or place an order." Applicant distinguishes its mark from that in the *Martin Container* case by stating that its mark, like *Dial-A-Mattress*, contains both letters and numbers, the usually-present parentheses around the "k" in "401(k)" are deleted, and there is no need for applicant's competitors to identify their services as "401K.COM services."

We affirm the refusal to register on the Supplemental Register because, as in *In re Martin Container, Inc.*, the matter for which registration is sought, 401K.COM, is incapable of identifying the source of applicant's services. While the mark in this case contains numbers and letters, it is not analogous to the mnemonic mark presented in *Dial-A-Mattress*. The evidence, in particular the nature and number of LEXIS/NEXIS excerpts, clearly establishes that the term 401k, both with and without parentheses around the "k," is used as the name of a widely-used type of retirement account and that, in the article excerpts, it is almost synonymous with the term "retirement account." The fact that this portion of applicant's mark, 401K, combines letters and numbers does not make it analogous to "1-888-

MATRESS" because, unlike "1-888-MATRESS," 401K is the term used to talk about the product which is the subject of applicant's services. As applicant's Internet web site indicates, its investment and financial services pertain entirely to 401k accounts and managing investments for retirement. Further, as stated in *In re Martin Container, Inc.*, *supra*, the term ".COM" is merely a top-level domain indicator (TLD), which is a necessary part of an address on the Internet. Regardless of whether ".COM" is a TLD for businesses only, or for businesses and private individuals, it remains a TLD and, as with business entity designations such as "INC." or "CO.," it has no source indicating significance to the purchasing public, and cannot serve any service mark purpose. See *In re Paint Products Co.*, 8 USPQ2d 1863 (TTAB 1988), ["PAINT PRODUCTS CO" held incapable of identifying and distinguishing paints], and *In re E.I. Kane, Inc.*, 221 USPQ 1203 (TTAB 1984), ["OFFICE MOVERS, INC." held incapable of identifying and distinguishing office facilities moving services]. See also: 1 J. McCarthy, *Mc Carthy on Trademarks & Unfair Competition*, Section 7:17.1 (4th ed. 2002) at 7-28.1 ["a top level domain ['TLD)'] indicator [such as '.com'] has no source indicating significance and cannot serve any trademark

[or service mark] purpose" and "the same is true of other non-distinctive modifiers used in domain names, such as 'http://www" and "html"; thus, because "the TLD '.com' functions in the world of cyberspace much like the generic indicators 'Inc.,' 'Co.,' or 'LTD.' placed after the name of a company," "[a] top level domain indicator like '.com' does not turn an otherwise unregistrable designation into a distinctive, registrable trademark [or service mark].

The mark, 401K.COM, is not a phrase, rather it is compound word, a generic term combined with a top-level domain indicator or TLD. Thus, having established that the two separate terms have the same meaning that common usage would ascribe to them as a compound, we find that 401K.COM used in connection with the identified services is incapable of registration on the Supplemental Register. *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987).

Decision: The refusal under Section 23 of the Act on the ground that the proposed mark is generic is affirmed.